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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,531	07/12/2006	George Telfer	3337.5	3131

29166 7590 03/06/2008

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EXAMINER	
HUTCHINS, CATHLEEN R	
ART UNIT	PAPER NUMBER
3672	

MAIL DATE	DELIVERY MODE
03/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/550,531	TELFER, GEORGE	
	Examiner	Art Unit	
	CATHLEEN R. HUTCHINS	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/1/2007, 8/21/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

The Election/ Restriction requirements between the apparatus and the method claims have been rescinded.

Claim Objections

1. Claims 2-12 and 14-20 objected to because of the following informalities: claims 2-12 should start "the cleaning tool", and claims 14-20 should start "the method". Appropriate correction is required.

2. Claim 9 objected to because of the following informalities: Polished Bore Receptacle should be all in lower case letters, and no acronyms given. Appropriate correction is required.

3. Claim 12 objected to because of the following informalities: claim 12 depends from claim 13. A dependent claim can not depend from a later claim. Additionally, there is no antecedent basis for "the end" from claim 13. It is assumed that applicant intended claim 12 to depend from claim 11. Appropriate correction is required.

4. Claims 13, 17, 18, 19, and 20 objected to because of the following informalities: PBR should be "polished bore receptacle". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14 and 17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claims 14 and 17 improperly claim both a device and a method of cleaning a liner top. See MPEP 2173.05 (p) II. Applicant is advised to maintain a clear line of demarcation between apparatus claims and method claims. Examiner is treating claims 14 and 17 as method claims, further providing for the apparatus as described in claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12 rejected under 35 U.S.C. 102(b) as being anticipated by Baker, US2275939, granted 3/10/1942.

a. Regarding claims 1-12, Baker teaches A cleaning tool **Fig 1 and Fig 2** for use on a work string, the tool comprising a cylindrical body **A** having an axial bore running there through, a plurality of eccentrically located cleaning elements **15** mounted thereon, the cleaning elements, with substantially rectangular cross-section **Fig 2: 15** to provide a first edge **18** between a side and an outer face, the outer faces having a curvature greater than a curvature of the cylindrical body **shown in Fig 2 and Fig 3**, with a profiled tapered end **30** and a profiled end providing a stop **29**, the elements located in at least one band **Fig 1 showing elements in one linear band** around the circumference of the body, located in a recess **16** of the body, the recess located longitudinally in the body and eccentric

Fig 2 shows 16 is eccentric to the axial bore; positioning means **19**- a biasing spring located in the recess, and held in compression to bias the element away from the body **page 2, col 1: 50-52**- to move the cleaning elements in relation to the cylindrical body from a first position to a second position, wherein, in the first position, the outer faces of the cleaning elements define a cylindrical surface centralized to the axial bore so that the elements provide a polishing action **Fig 2, wherein one position can be aligned to match the curvature of the elements 15**, and, in the second position, the outer faces present leading edges providing a scraping action **Fig 2 or Fig 3, wherein the edges have a different curvature than the casing**, and the faces are located outwardly of the first position. The outer face comprises a material softer or more malleable than the material of a polished bore receptacle **wherein the spring 19 is more malleable than a casing or polished bore receptacle, and is part of the outer face**. The end comprises a mill **18**, so that the tool acts as a top dress mill.

9. Claims 13, 15, 16, 19, and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Telfer, WO98/35131, published 8/13/1998.

b. Regarding claims 13, 15, 16, 19, and 20, Telfer teaches a method of cleaning a liner top, the method comprising the steps; (a) inserting a cleaning tool into a liner **p2: 17-38**; (b) running the tool and liner together into a well bore **p2:17-38**; (c) setting the liner at a casing in the well bore **p2:17-38**; (d) rotating and/or reciprocating the tool to clean an inner surface of a PBR on the liner with cleaning elements thereon **p24: 23-32**; (e) pulling the tool from the PBR, so that

the cleaning elements move outwardly to contact neighboring casing at the liner top **p2: 27-29**; (f) rotating and/or reciprocating the tool to clean an inner surface of the neighboring casing with the leading edges of the cleaning elements **claim 28**; tripping the tool from the wellbore **claim 28, wherein raising the tool string equivalent to tripping from the wellbore**; attaching the tool to a liner setting tool **p24: 23-24, wherein the liner setting arrangement is equivalent to the liner setting tool**, so that the tool is tripped out with the setting tool; dressing a top of the polished bore receptacle **p1:27-30, wherein removing cement from the top of the liner is equivalent to dressing the top of a polished bore receptacle**; setting down weight on the tool to set a packer **Fig 4: 56**.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 14 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Telfer as applied to claim 13 above, and further in view of Baker.

c. Regarding claim 14, Telfer teaches all of the elements of claim 13, and a cleaning tool **Fig 13** for use on a work string, the tool comprising a cylindrical body **500** having an axial bore running there through, a plurality of cleaning elements **505** mounted thereon, the cleaning elements having outer faces **515**, and, positioning means **506** to move the cleaning elements in relation to the cylindrical body from a first position to a second position **wherein many different positions may be achieved**, wherein, in the first position, the outer faces of the cleaning elements define a cylindrical surface centralized to the axial bore so that the elements provide a polishing action, and, in the second position, the outer faces present leading edges providing a scraping action **wherein scraping occurs on 515**. Telfer does not teach the cleaning elements being eccentrically located, or the outer faces having a curvature. Baker teaches the cleaning tool of claim 1, with outer faces having a curvature **Fig 2**. It would have been obvious to a person having ordinary skill in the art of designing scraping tools at the time of the instant invention to modify Telfer in view of Baker, to have eccentrically located cleaning elements with outer faces having a curvature, in order to provide a leading edge to scrape the inner surface of a tube, as taught by Baker in Fig 2.

13. Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Telfer as applied to claim 13 above.

d. Telfer teaches all of the method steps of claim 13, but does not specifically teach the step of running the tool back into the polished bore receptacle. However, Telfer does suggest that running the tool back into the polished bore receptacle may be done during the operation of a scraper **Abstract: wherein obviating the need to have a separate trip to remove cement from the liner indicates that a second trip with the scraper is known**. It would have been obvious to a person having ordinary skill in the art of designing scraping tools at the time of the instant invention to modify Telfer to add the step of running the tool back into the polished bore receptacle, in order to remove additional cement, which may have not been removed upon the first run of the scraper/ cleaning tool.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

e. Best teaches a pipe scraper.

f. Bishop, et al. teaches a casing scraper with eccentrically oriented spring biased elements.

g. Brown teaches a spring biased eccentrically oriented casing scraper.

h. Bunney teaches a spring biased scraper.

i. Bussear teaches a method of cleaning a PBR.

j. Carmichael, et al. teaches a leaf spring used to bias a scraper element.

k. Conrad teaches a spring biased eccentrically oriented casing scraper.

l. Coyle teaches a spring biased eccentrically oriented casing scraper.

m. Hirth teaches a method of running a packer and cleaner in with a PBR.

n. Howlett, et al. ' 982 (and WO03/036014) teaches a spring biased eccentrically oriented casing scraper.

o. Howlett, et al. '950 (and WO/02/35055) teaches a method of 1 trip cleaning of polished bore and scraping.

p. Howlett, et al. '064 teaches a packer with a PBR.

q. Ledyashov, et al. teaches concentrically arranged scrapers biased via hydraulic forces.

r. Murley, et al. teaches cementing a liner, and cleaning with a dart.

s. Pampell teaches a well scraper.

t. Ragan teaches a well scraper.

u. Springer teaches a well scraper.

v. Telfer '945 teaches the same invention as WO98/35131.

w. Tulloch, et al. teaches a spring biased scraper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHLEEN R. HUTCHINS whose telephone number is (571)270-3651. The examiner can normally be reached on Mon thru Thurs 7:30-5, alternate Fri 7:30-4 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CRH/

/Kenneth Thompson/
Primary Examiner, Art Unit 3672